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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,516	10/03/2000	Randy Gray Simmons	17499	5361

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EXAMINER

GUSHI, ROSS N

ART UNIT PAPER NUMBER

2833

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/678,516

Applicant(s)

SIMMONS ET AL.

Examiner

Ross N. Gushi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 27-30 is/are allowed.
- 6) ☐ Claim(s) 1,4-13 and 16-23 is/are rejected.
- 7) ☐ Claim(s) 14 and 24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-10 and 16-23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Essential matter regarding the technical specifications of "RJ-xx series" connectors critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application. See MPEP Section 608.01(p). The subject matter incorporated by reference at applicant's specification page 1, line 20 – page 2, line 5 is essential material which may not be incorporated by reference. Applicant's claimed invention

includes references to various standards which may not be incorporated by reference.

The limitations regarding technical requirements of "RJ-standards" are given no weight.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Tor et al. ("Tor"). Tor discloses a modular jack connector assembly 10 comprising a dielectric housing having a front face and a rear face, the front face defining at least one receptacle adapted for receiving a mating plug, the rear face defining a transverse slot (at 42) for receiving board 20, and a plurality of contacts disposed in said housing, each contact being secured at a point between first and second free ends, each contact extending forward in said receptacle and including connection portion 12 of each contact extending into the slot to make contact with the board.

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Per claim 13, the Tor housing comprises one receptacle.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliphant.

Oliphant discloses a modular jack connector assembly comprising a dielectric housing having a front and rear orientation and defining at least one receptacle adapted for receiving a mating plug; and a plurality of contacts disposed in said housing, each contact being secured to a rear portion of said housing, each contact extending forward into the receptacle from said rear portion to a free end such that a portion of said contact forward of said rear portion electrically connects with a mating plug when the mating plug is received within said receptacle, said housing has a rear side defining a slot suitable for receiving an edge of a circuit board, and wherein a connection portion of each contact extends from said rear portion of said housing into said slot such that when said housing is mounted to a circuit board a portion of said connection portion makes contact with the circuit board. To the extent that Oliphant is not explicit in stating that the mating plugs are RJ "standard" compliant, at the time of the invention, it would have been obvious to have the connector be mateable with "RG standard compliant" plugs. The suggestion or motivation for doing so would have been to allow the

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connector to be used with standardized parts, as suggested in Oliphant, col. 5, lines 1-6, and as is well known in the art.

Regarding claims 16, 17, 18, 19, 20, and 23, regarding the relative dimensions, strengths, and proportions of the contact, to the extent that Oliphant does not detail relative dimensions, strengths, and proportions of the contacts, at the time of the invention, it would have been obvious to one with ordinary skill in the art that the contact dimensions, strengths, or proportions could be varied as desired. The suggestion or motivation for doing so would have been for example to improve durability and to obtain desired compliance, such motivations being well known in the art. Furthermore, the claimed variations in relative sizes, proportions, or dimensions, of the contacts, where the claimed device does not perform differently compared to the prior art device, do not patentably distinguish the claimed invention from the prior art. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed Cir. 1984).

Regarding claims 21 and 22, to the extent that Oliphant is not explicit in stating that the connector is configured to receive RJ-45 or RJ-11 "standard" plugs, at the time of the invention, it would have been obvious to construct the Oliphant device so as to receive standard plugs. The suggestion or motivation for doing so would have been to allow the connector to be used with standardized parts, as is well known in the art.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tor as in claim 1. Regarding claims 11 and 12 regarding the relative dimensions, strengths, and proportions of the contact, to the extent that Tor does not detail relative dimensions, strengths, and proportions of the contacts, at the time of the invention, it

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would have been obvious to one with ordinary skill in the art that the contact dimensions, strengths, or proportions could be varied as desired. The suggestion or motivation for doing so would have been for example to improve durability and to obtain desired compliance, such motivations being well known in the art. Furthermore, the claimed variations in relative sizes, proportions, or dimensions, of the contacts, where the claimed device does not perform differently compared to the prior art device, do not patentably distinguish the claimed invention from the prior art. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed Cir. 1984).

### ***Response to Arguments***

Applicant's arguments filed 5/22/03 have been fully considered but they are moot in view of the new grounds of rejection.

Applicant requests that claims 16-23 be temporarily withdrawn from prosecution until a further amendment is filed. It is not clear to the examiner that such a request is proper under the applicable rules and statutes. The examiner requests that the legal basis for the withdrawal request be identified. As it is not clear to the examiner that a temporary withdrawal of claims 16-23 is proper, in this action, the rejection under 35 USC 112 in question is maintained and the action is made final.

### ***Allowable Subject Matter***

Claims 4-10, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Regarding claim 4, the prior art does not

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suggest the as claimed, including the combination of all the claimed elements, the combination including that the receptacle is configured to receive a plug conforming to the RJ standard.

Claims 14, 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 14, the prior art does not suggest the as claimed, including the combination of all the claimed elements, the combination including that the housing comprises two or more receptacles.

Regarding claim 24, the prior art does not suggest the device as claimed, including the combination of all the claimed elements, the combination including that the contact consists essentially of the free end, the upwardly angled section, the elongated arm, and the connection portion as claimed.

Claims 15 and 27-30 are allowable. The prior art does not suggest the PCMCIA card as claimed, including the combination of all the claimed elements, the combination including the housing including the slot as claimed and including the contact secured at a point between free ends as claimed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (703) 306-4508. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at (703) 308-2319. The phone number for the Group's facsimile is (703) 308-7722

rng

A handwritten signature in black ink, appearing to read "Ross Gushi", with a stylized flourish at the end.